

REMARKS

Claims 1-8, 10, 12, 13 and 17-24 are pending. Claims 1-8, 10, 12, 13 and 17-24 have been rejected.

The Amendments to the Claims

Applicants have amended claim 22 to recite “an antimicrobial mixture” in paragraph (i)(b). The amendment is supported throughout the specification as filed, *e.g.*, on page 3, line 19 to page 4, line 17.

The Rejections Under 35 U.S.C. § 112, second paragraph

The Office Action has rejected claim 22, alleging that the claim’s reference to “... a mixture consisting essentially of ...” fails to point out that it is an “*antimicrobial* mixture.” The Examiner suggests adding “antimicrobial” to correct the deficiency.

Applicants appreciate the Examiner’s suggestion, which is adopted and reflected in amended claim 22. As such, Applicants submit that claim 22 now satisfies 35 U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request the rejection be withdrawn.

The Nonstatutory Double Patenting Rejections

The Rejections over U.S. Patent No. 6,872,195

The Office Action has rejected claims 1-8, 10, 17, and 20-23 on the grounds of nonstatutory double patenting rejection, as being unpatentable over claims 1, 2, 4, 8-19 of U.S. Patent No. 6,872,195 (“the ‘195 patent”). The Office Action contends that the ‘195 patent claims a medical article treated with a solution comprising chlorhexidine that consists essentially of a mixture of chlorhexidine free base and a chlorhexidine salt. Further, the Office Action contends that the article may be made up of hydrophilic polymers, may be a catheter, and the method of preparation involves soaking the article in the solution of chlorhexidine and a solvent, such as tetrahydrofuran, water or reagent alcohol, allowing sufficient time for the article to swell. The Office Action contends that the soaking conditions comprise a hydrogel.

The Office Action alleges that, although the '195 patent does not specify the percentage of chlorhexidine salt to chlorhexidine free base, or the exact ratio of solvent components, the '195 patent claims the inventive concept of using the combination of chlorhexidine free base and chlorhexidine salt in combination to treat a catheter. The Office Action alleges that the ratios and the duration of soaking can be modified to the instantly claimed parameters without undue experimentation as a means of optimizing the antimicrobial properties of the catheter coating as taught by the '195 patent.

In reply, Applicants provide herewith a terminal disclaimer, disclaiming the portion of a patent term granted on the instant claims that extends past the patent term of the '195 patent.

The Rejections Over U.S. Patent Application No. 10/600,257

The Office Action has rejected claims 1-8, 10, 12, 13, and 17-24 under a provisional nonstatutory double patenting rejection as obvious over application No. 10/600,257 (the '257 application"). The Office Action alleges that the '257 application claims an antimicrobial medical article comprising a mixture of chlorhexidine free base and chlorhexidine salt in a weight/weight ratios of between 1:1 and 1:5. Solvent mixture are alleged to be listed in claims 7-9 and 12-15 of the '257 application, and the chlorhexidine salt is specified as chlorhexidine diacetate in claims 10, 16, 24 and 31. The Office Action contends that the article is identified as a catheter in claim 58, and further, that the duration of soaking can be easily modified by one of skill in the art. As such, the Office Action contends that one ordinarily skill in the art would have expected similar antimicrobial properties from the instantly claimed catheter, given the claims of the '257 application.

The Office Action notes that the rejection is a provisional double patenting rejection, the conflicting claims not having yet been patented. In response, Applicants respectfully request that, since the claims of the '257 application have not been found patentable, the provisional double patenting rejection be held in abeyance until the claims of the '257 application are deemed patentable.

Formal Request for Interview

Applicants submit that the present application is in condition for allowance at least for the reasons set forth herein. If the present application is not considered to be in condition for allowance by the Examiner, and pursuant to M.P.E.P. § 713.09, Applicants requests an interview with the Examiner to discuss the present application and the prior art of record. Applicant's Attorney, Lisa B. Kole may be reached by telephone at (212) 408-2628 to schedule a mutually convenient date and time and to provide assistance or additional information as required.

Conclusion

Applicants believe that in light of the foregoing remarks, the claims are in condition for allowance, and accordingly, respectfully request withdrawal of the outstanding rejections. An allowance is earnestly sought.

Applicant believes that no fee is due in connection with the filing of this Reply. However, Applicant authorizes, in the Fee Transmittal Form the Director to charge payment of any fees or credit any overpayment associated with this Reply to Deposit Account No. 02-4377.

Respectfully submitted,



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